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EXAMINER

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PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* PING-WEN ONG
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11 Appeal 2009-004853
12 Application 09/201,749
13 Technology Center 3600
14

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16 Decided: January 25, 2010
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18 *Before* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
19 R. MOHANTY, *Administrative Patent Judges*.

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21 CRAWFORD, *Administrative Patent Judge*.
22

23
24 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-3, 5-10, 12-18, 20-24, and 26-28¹. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented systems and methods for providing persistent storage of Web resources by augmenting Uniform Resource Locators (“URLS”) to include a time stamp (Abstract).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A method for providing an electronic document, said electronic document having multiple versions, each of said versions identified by a creation time-stamp indicating a creation time of said corresponding version, said method comprising the steps of:

receiving a request for said electronic document, said request including a requested time-stamp indicating a time associated with a desired version of said electronic document and a requested domain name associated with said time-stamp;

identifying as a function of said creation time-stamp and said requested time-stamp a desired version of said electronic document having a creation time corresponding to said requested time-stamp; and

identifying an address of said desired version of said electronic document stored on a server corresponding to said requested time-stamp as a function of said requested timestamp and said requested domain name, wherein a server identified by said requested domain name does not provide said desired version at a time of said request and said identified server has a redirected domain name that is different than said requested domain name.

¹ Claims 4, 11, 19, and 25 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 29-35 are withdrawn from consideration.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

KANFI	US 5,559,991	Sept. 24, 1996
AMSTEIN	US 5,793,966	Aug. 11, 1998

The Examiner rejected claims 1, 6, 8, 12, 15, 16, 20, 22, 26, and 28 under 35 U.S.C. § 112, second paragraph, for indefiniteness; rejected claims 1-3, 5-7, 9, 10, 12-16, 18, 20-24, and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Amstein; and rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Kanfi in view of Amstein.

We AFFIRM-IN-PART.

ISSUES

Did the Appellant show the Examiner erred in rejecting claims 1, 6, 8, 12, 15, 16, 20, 22, 26, and 28 under 35 U.S.C. § 112, second paragraph, for indefiniteness?

Did the Appellant show the Examiner erred in asserting that the updated document meta information file of Amstein corresponds to “wherein a [server/machine] identified by said requested domain name does not provide said desired version at a time of said request and said identified server has a redirected domain name that is different than said requested domain name,” as recited in independent claims 1, 8, 15, 16, 22, and 28?

FINDINGS OF FACT

Specification

Appellant invented systems and methods for providing persistent

1 storage of Web resources by augmenting Uniform Resource Locators
2 (“URLS”) to include a time stamp (Abstract).

3
4 *Amstein*

5 Amstein discloses computer systems for creating, developing, and/or
6 modifying on-line services in a client-server information system (col. 1, ll.
7 9-11).

8 Each web or service has a location 400 on the server where all the
9 document objects and associated information of the web is stored (col. 17, ll.
10 33-35).

11 Meta-information, or information about information, is also stored.
12 First, document meta-information, or information about a particular web
13 document object, such as the title of the document, the author of the
14 document, the date and time that the document was created, and the date and
15 time that the document was last modified, may be stored in another location
16 406 on the server. The document meta-information may also include a list
17 of hypertext links from the document to other document objects (col. 17, ll.
18 55-63).

19 The attribute “vti_cachedbasedtm” gives the date and time of last
20 modification to any of the cached attribute values, in this case “19 Nov.
21 1995 10:47:2 EST”. The attribute “vti_cachedtitledtm” gives the date and
22 time of last modification to the “vti_cachedtitle” attribute value, in this case
23 “19 Nov. 1995 10:47:50 EST”. The attribute “vti_cachedlinkedinfo” gives
24 the list of document that this document links to, in this case the first link is
25 to “images/logo.gif”. The attribute “vti_cachedlinkedinfotm” gives the date
26 and time of last modification to the “vti_cachedlinkedinfo” attribute value,

1 in this case, "19 Nov. 1995 10:47:42 EST". The attribute
2 "vti_timelastmodified" gives the time at which the document was last
3 modified, in this case "19 Nov. 1995 10:47:33 EST". The attribute
4 "vti_timecreated" gives the time at which the document was created, in this
5 case "19 Nov. 1995 10:47:33 EST" (col. 19, ll. 28-47).

6 The attribute "vti_autorecalc" indicates whether the server extension
7 program must automatically recalculate document dependencies after a
8 document object is saved to the server (col. 20, ll. 13-16).

9 The document meta information file is updated as follows. The value
10 of the "vti_timelastmodified" attribute is changed to the current time, to
11 indicate the time at which the document was last modified. The value of the
12 "vti_cachedlinkinfo" attribute is changed to be the current list of documents
13 or images that the current document either includes or has links to, so that
14 the list reflects any additions or deletions of links in the new version of the
15 document. The value of the "vti_cachedlinkinfodtm" attribute is changed to
16 the current time, to indicate the time at which the value of the
17 "vti_cachedlinkinfo" attribute was last updated. The value of the
18 "vti_cachedtitledtm" attribute is changed to the current time, to indicate the
19 time at which the value of the "vti_cachedtitle" attribute was last updated.
20 The attribute "vti_cachedbasedtm" is changed to the current date and time,
21 indicating the most recent modification to any of the cached attribute values.
22 The attributes "vti_timecreated" and "vti_author" are not changed, since
23 these give information about the creation of the document. After meta-
24 information is updated, the document dependency database and the text
25 index of all documents in the web are both updated to reflect the changes in
26 the saved document (col. 24, ll. 31-64).

PRINCIPLES OF LAW

Claim Construction

The context of the surrounding words of the claim must be considered in determining the ordinary and customary meaning of those terms. *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003).

Indefiniteness

A claim is definite if “one skilled in the art would understand the bounds of the claim when read in light of the specification.” *Personalized Media Communications, LLC v. ITC*, 161 F.3d 696, 705 (Fed. Cir. 1998).

Breadth is not indefiniteness. *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970).

If a claim is subject to two interpretations as the examiner suggests is the case here and one interpretation would render the claim unpatentable over the prior art, we believe the proper course of action is for the examiner to enter two rejections: (1) a rejection based on indefiniteness under 35 U.S.C. §112, second paragraph, and (2) a rejection over the prior art based on the interpretation of the claims which renders the prior art applicable. Entry of simultaneous rejections avoids piecemeal appellate review. *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. Pat. App. & Int. 1984) (citing, e.g., *In re Marosi*, 710 F.2d 799 (Fed. Cir. 1983); *Tofe v. Winchell*, 645 F.2d 58, (CCPA 1981); *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed.Cir. 1983)).

Obviousness

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)

During examination, the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Indefiniteness

We are persuaded of some error on the part of the Examiner by Appellant's argument that claims 1, 6, 8, 12, 15, 16, 20, 22, 26, and 28 are not indefinite under 35 U.S.C. § 112, second paragraph (App. Br. 7; Reply Br. 2-4).

The Examiner asserts that there is insufficient antecedent basis for the multiple recitations of "a time" in independent claims 1, 8, 15, 16, 22, and 28 (Examiner's Ans. 4-5, 10-11). However, the multiple recitations of "a time" are not read in a vacuum, but must be considered in the context of the rest of the claim. *See ACTV, Inc. v. Walt Disney Co.*, 346 F.3d at 1088.

Taken in context, the multiple recitations of "a time" are not indefinite because each recitation of "a time" is followed by what the time is associated with. For example, independent claim 1 recites "a time associated with a desired version of said electronic document" and "a time of said request." Accordingly, one of ordinary skill in the art would understand how each recitation of "a time" differs from the others. *See*

1 *Personalized Media Communications, LLC v. ITC*, 161 F.3d at 705. A
2 similar analysis can be applied to independent claims 8, 15, 16, 22, and 28.

3 By contrast, the same analysis does not hold true for the multiple
4 recitations of “a desired version” in independent claims 1, 8, and 15. Here,
5 the second recitation of “a desired version” in the paragraph beginning with
6 “identifying as a function” is the same as the recitation of “a desired
7 version” in the paragraph beginning with “receiving.” Indeed, Appellant
8 admits that “one or more of the instances of a desired versions may identify
9 the same document” (App. Br. 7). The use of “may” injects ambiguity that
10 makes the terms indefinite. Accordingly, either the second recitation of “a
11 desired version” should be “said desired version,” as set forth in the
12 paragraph beginning with “identifying an address” as recited in independent
13 claim 1, or “a desired version” should be named something else if it truly is
14 different from the first desired version.

15 The recitation of “a time” in independent claims 1, 8, 15, 16, 22, and
16 28 is not indefinite because “a time” could mean any time such as “a minute
17 or a second or an hour or a day or a week or a month or a year” (Ex. Ans.
18 11). One of ordinary skill understands that “a time” could be in any of these
19 units, but that a specific time using whichever units would still be required
20 (e.g., “19 Nov. 1995 10:47:33 EST”). *See Personalized Media*
21 *Communications, LLC v. ITC*, 161 F.3d at 705. The fact that “a time” could
22 be broad does not render it indefinite. *See In re Gardner*, 427 F.2d at 788.

23 The Examiner asserts that “said request” in “said request is specified
24 using a browser,” as recited in dependent claims 6, 12, 20 and 26, is
25 indefinite because it is unclear which “request” in respective independent
26 claims 1, 8, 15 and 22 is being referenced (Examiner’s Ans. 7, 11).

1 However, independent claims 1, 8, 15 and 22 each recite “a request for said
2 electronic document,” with the “requested time-stamp” and “requested
3 domain name” being subsets of the “request.” Accordingly, independent
4 claims 1, 8, 15 and 22 each recite only one “request.”

5

6 *Desired Version*

7 While certain aspects of independent claims 1, 8, and 15 are not
8 completely clear, in the interest of judicial economy, we will review the
9 prior art rejections. For this purpose, we construe the second recitation of “a
10 desired version” as being “said desired version.”

11 We are persuaded of error on the part of the Examiner by Appellant’s
12 argument that the updated document meta information file of Amstein does
13 not correspond to “wherein a [server/machine] identified by said requested
14 domain name does not provide said desired version at a time of said request
15 and said identified server has a redirected domain name that is different than
16 said requested domain name,” as recited in independent claims 1, 8, 15, 16,
17 22, and 28 (App. Br. 8-11, Reply Br. 3, 5-8). Amstein discloses electronic
18 documents including meta-information containing various time data related
19 to the creation and modification of a *current* version of the electronic
20 document. However, the recited “desired version” of the electronic
21 document is a version *previous to* the current version of the electronic
22 document. This is recited in the independent claims as the server/machine
23 “does not provide said desired version at a time of said request.” In other
24 words, the desired version is not the version that is current at the time of said
25 request. The portions of Amstein cited by the Examiner do not disclose

1 providing a version of an electronic document previous to the current
2 version.

3 Furthermore, the Examiner admits that “Amstein did not expressly
4 disclose that the server is identified by the requested domain name”
5 (Examiner’s Ans. 6). Thus, the Examiner admits that Amstein does not
6 disclose that “said identified server has a redirected domain name that is
7 different than said requested domain name,” as recited in independent claims
8 1, 8, 15, 16, 22, and 28. The Examiner then asserts that “Amstein discusses
9 a server in col. 20, lines 13-16 which could be used to perform this step in
10 claim 1,” and that “it would have been obvious to one having ordinary skill
11 in the art at the time the invention was made to incorporate the server being
12 identified by the requested domain name with the identified server having a
13 redirected domain name because such feature would make the web pages
14 (HTML files) available to be viewed by the web browser at a redirected web
15 site on the Internet” (Examiner’s Ans. 6-7). However, these are mere
16 conclusory statements that modifying Amstein would result in the
17 aforementioned recitation of independent claims 1, 8, 15, 16, 22, and 28,
18 without the required articulated reasoning with rational underpinnings as to
19 why one of ordinary skill would modify Amstein to include these recitations.
20 *See In re Kahn*, 441 F.3d at 988. Accordingly, as the Examiner has not
21 provided a proper case of prima facie obviousness, we will not sustain the
22 rejections of independent claims 1, 8, 15, 16, 22, and 28, and the rejections
23 of their dependent claims 2, 3, 5-7, 9, 10, 12-14, 17, 18, 20, 21, 23, 24, 26,
24 and 27.

CONCLUSION OF LAW

On the record before us, Appellant has shown that the Examiner erred in rejecting claims 6, 12, 16, 20, 22, 26, and 28 under 35 U.S.C. § 112, second paragraph.

On the record before us, Appellant has not shown that the Examiner erred in rejecting claims 1, 8, and 15 under 35 U.S.C. § 112, second paragraph.

On the record before us, Appellant has shown that the Examiner erred in rejecting claims 1-3, 5-10, 12-18, 20-24, and 26-28 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 2, 3, 5-7, 9, 10, 12-14, 16-18, 20-24, and 26-28 is reversed.

The decision of the Examiner to reject claims 1, 8, and 15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

MP

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